IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
)	
David R. FERGUSON et al.)	Group Art Unit: 2172
)	
Application No.: 08/947,435)	Examiner: E. Colbert
)	
Filed: October 8, 1997)	Appeal No. Unassigned
)	
For: COMPUTER-BASED DOCUMENT)	
MANAGEMENT SYSTEM)	

REPLY BRIEF FOR APPELLANT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In accordance with 37 C.F.R. §1.193(b)(1) Appellant submits herewith a Reply Brief in response to the Examiner's Answer mailed on May 8, 2001. Two extra copies of this Reply Brief are being submitted herewith.

Appellants respectfully acknowledge the Examiner's Answer, but continue to disagree with the Examiner's position for at least the reason that the Examiner has not established a proper *prima facie* basis for the rejection of claims 1-28, 30-46 and 51 under 35 U.S.C. §103(a) as allegedly being obvious over various combinations of U.S. Patent No. 5,625,818 ("Zarmer"), U.S. Patent No. 5,628,003 ("Fujisawa"), and U. S. Patent No. 5,727,175 ("Malone").

It is well known that in order to establish a proper *prima facie* case of obviousness three basic criteria must be met. More specifically, in order to establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally known in the art to modify the reference or to combine reference teachings, there must be a reasonable expectation of success, and the reference/references must teach or suggest all of the claimed limitations. In the present case, the Appellants contend that a *prima facie* case of obviousness is not established because the prior art reference/references (i.e., Zarmer, Fujisawa and Malone) fails to teach or suggest all of the features recited in claims 1-28,

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-1-

30-46 and 51, and because the neither the Examiner's Answer nor the previously issued Office Actions present a valid reason why one of ordinary skill in the art would be motivated to modify the teachings of applied prior art references, in the manner suggested by the Examiner. Further, as discussed in the Brief for Appellant ("Appeal Brief") the Examiner fails to interpret the claims as a whole as is clearly set forth in the statute.

In response to Appellants' arguments presented in the Appeal Brief, the Examiner's Answer, in addition to repeating the rejections presented in the final Office Action, elaborates slightly on the previous rejection of claims 1 and 2 by asserting that the step of automatically extracting attribute data from an imported document is disclosed in Zarmer inasmuch as Zarmer discloses a document management system which utilizes an object managing utility referred to as "ObjectMan", and that persistence storage of document attributes is taught in column 11. To support this assertion the Examiner's Answer points to column 11, lines 13-37, and column 12, lines 10-34 of Zarmer. This assertion is unfounded for the following reasons.

The cited passages (i.e., column 11, lines 13-37 and column 12, lines 10-34 of Zarmer) discusses "ObjectMan" which is the persistent object store used in the electronic publishing tool of Zarmer. The general services performed by ObjectMan include generating globally unique IDs for generic use. ObjectMan also provides the ability to access a specified object, and the ability to iterate through an object's interested parties. Further, ObjectMan provides various services for persistent objects (i.e., objects which are saved in a database), including automatic retrieval of an object, automatic deletion of an object from memory when other objects are done with it, automatic deletion of an object from the database when no other objects are interested in it, and delivery and synchronization of changes at a remote site. However, nowhere in the cited passage, or elsewhere in Zarmer, is there any disclosure or suggestion of the steps of automatically extracting attribute data from an imported electronic document, generating a separate data structure, in which said extracted attribute data is stored and maintained in memory separate from the imported document, and linking the imported document to an electronic folder if the attribute data contained in said data structure matches a set of predefined criteria associated with the electronic folder, as recited in Appellants' claim 1.

With regard to the Examiner's Answer's assertion that "persistence storage" of document attributes is taught in column 11 of Zarmer, the Appellants' fail to see the relevance of such a disclosure. The Appellants do not assert that the storage of attributes per se is novel. To the contrary, the invention address a method (i.e., a combination of steps) which result in a novel outcome. The fact that an individual step in and of itself may be known in the art is not sufficient to render the claim as a whole unpatentable.

In response to Appellants' argument that the previously issued Office Action failed to present a valid reason why one of ordinary skill in the art would be motivated to modify the teachings of Zarmer, the Examiner's Answer *now* asserts that it "would have been obvious to a person of ordinary skill in the art at the time the invention was made to construct a folder for linking imported documents to avoid processing of the documents that are already registered in a database...and thus improve system performance." Further the Examiner's Answer asserts that it would have been within the "general knowledge of a person skilled in the art to use data, for instance today's date, as an attribute to do so." However, the Examiner's assertions are not persuasive for the following reasons.

First, the "motivation" provided in the Examiner's Answer was not previously provided and therefore is a newly presented rejection to Appellants have not had an opportunity to respond. Second, since Zarmer fails to disclose or suggest the steps of automatically extracting attribute data and generating a data structure as recited in claim 1, even if one skilled in the art where motivated to modify Zarmer, as now suggested by the Examiner's Answer, Zarmer would still fail to disclose or suggest all of the features of the invention as recited in claim 1. Accordingly, the Examiner's conclusion that claims 1 and 2 are obvious in view of Zarmer is clearly based on hindsight reconstruction of the individual elements of the claims, without any legal basis with which to support such a conclusion.

In response to Appellants' arguments that the combination of Zarmer, Fujisawa, and Malone do not disclose or suggest all of the features of the invention as claimed in claims 2-28 and 30-46, the Examiner's Answer asserts that the combination of Zarmer, Fujisawa, and Malone either teaches the claim limitations, or the claim limitations are well known in that art or

-3-

obvious to one having ordinary skill in the art. However, the Examiner has not provided any evidence to substantiate such a conclusion. To the contrary the Examiner has merely asserted that a particular step is either well-known in the art or obvious to one of skill in the art. Again, the Examiner appears to be making conclusions which are clearly based on hindsight reconstruction of the individual elements of the claims, without any legal basis with which to support said conclusions. For example, the Examiner's Answer asserts that features are well known in art, however, the Examiner fails to provide any prior art reference to support such as conclusion. Further, the Examiner's statements that missing features are obvious is a legal conclusion which can only be reached by following *Graham v. Deere*; however, the Examiner fails to follow the basic considerations which apply to obviousness rejections, i.e., the claims invention must be considered as a whole; the references must be considered as a whole and must suggest the desire ability and thus the obviousness of making the consideration; the references must be viewed without the benefit of impermissible hindsight vision; and there must be a reasonable expectation of success (see MPEP §2141). Accordingly, the Examiner's rejections of the pending claims in view of the various combination of Zarmer, Fujisawa and Malone is improper.

For at least the foregoing reasons, it is respectfully requested that the final rejection of claims 1-28, 30-46 and 51 under 35 U.S.C. §103(a) be REVERSED.

Respectfully submitted,

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